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**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/421,422	10/19/99	HARBURY	P 8600-0197.30

022918 HM12/1121  
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EXAMINER

PONNALURI, P

ART UNIT	PAPER NUMBER
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1627

DATE MAILED: 11/21/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/421,422

Applicant(s)

Harbury et al

Examiner

P. Ponnaluri

Group Art Unit

1627



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire \_\_\_\_\_ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-14 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-14 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

*PTO FAX cover sheet*

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Claims 1-14 are currently pending in this application.

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, a dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Ph.D., Supervisory Patent Examiner at jyothsna.venkat@uspto.gov or 703-308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

***Election/Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-10, drawn to a method of synthesizing a plurality of compounds, classified in class 436, subclass 518.
  - II. Claims 11-13, drawn to a library of nucleic acid tags, classified in class 536, subclass 23.1.
  - III. Claim 14, drawn to a combinatorial library of compounds, classified in class 436, subclass 518.
3. The inventions are distinct, each from the other because of the following reasons:

Inventions of group I and group III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as

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claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the inventions of group I are drawn to a method of synthesizing a plurality of compounds (a process of making) and group III inventions are drawn to a combinatorial library of compounds (which can differ). The group I inventions can be used in making other kinds of library of compounds and group III process can be made using solution phase synthesis or solid phase synthesis. Thus, the restriction among the groups is proper.

4. Inventions of group II and group I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the library of nucleic acid tags can be used other than the probes, and the group I inventions can use different kinds of tags, such as chemical tags, fluorescent tags or peptide tags. Thus restriction among the groups is proper.

5. Inventions of group II and group III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, inventions of group II has separate utility such as the library of nucleic acids can be used in therapy, and in diagnostics. See MPEP § 806.05(d).

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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7. Claims 1-10 and 14 are generic to a plurality of disclosed patentably distinct species comprising 'compounds' which would read on oligonucleotides, oligonucleotide analogs, oligopeptides, oligopeptide analogs, oligosaccharides, lipopeptides, glycopeptides, small-molecule compounds which are non-oligomeric. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

10. Applicant is required to reply to this restriction requirement within 30 days of mailing this action. See MPEP 809.2(a).

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Any inquiry concerning this communication should be directed to P. Ponnaluri whose telephone number is (703) 305-3884. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached at (703)308-2439. The fax number for this group is (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-0196.



P. Ponnaluri  
Patent Examiner  
Technology center 1600  
Art Unit 1627  
20 November 2000



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

PAGES, INCLUDING COVERSHEET:

PHONE NUMBER:

TO EXAMINER: **P. Ponnaluri**

ART UNIT: **1627**

SERIAL NUMBER: **09/421,422**

FAX/TELECOPIER NUMBER: (703) 308-4315

**PLEASE NOTE: THIS FACSIMILE NUMBER IS TO BE USED ONLY  
FOR RESPONSES TO RESTRICTIONS.**

COMMENTS: \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

IF YOU HAVE NOT RECEIVED ALL THE PAGES OF THIS TRANSMISSION, PLEASE CONTACT THE ATTORNEY AT THE TELEPHONE NUMBER LISTED ABOVE.

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